

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Byung-in MA et al.

Serial No. 09/815,345

Group Art Unit: 2651

Confirmation No. 4409

Filed: March 23, 2001

Examiner: Gautam Patel

For: APPARATUS FOR GENERATING SEEK DIRECTION DETECTING SIGNAL FOR AN
OPTICAL PICKUP

Selection
12/3/03
JK

RESPONSE TO RESTRICTION REQUIREMENT

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Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Technology Center 2600

Sir:

This is responsive to the Office Action mailed October 23, 2003, having a shortened period for response set to expire on November 24, 2003 (November 23 being a Sunday), the following remarks are provided.

I. Provisional Election of Claims Pursuant to 37 CFR §1.142

In view of the above, Applicants provisionally elect claims 1-5, 8, 9, 12-14, 16-18, and 37-39 of Subspecies A of Species b in response to the preliminary restriction requirement set forth in the Office Action.

II. Applicants Traverse the Requirement

By way of review, the Examiner asserts that claims 1-5, 8, 9, 12-14, 16-18, and 37-39 of Subspecies A and claims 19, 20, 23-25, 28, and 30-33 of Subspecies B are related as a combination and subcombination. The Examiner further asserts that the subcombination has a separate utility and that the combination does not require the particulars of the subcombination. However, it is noted that, even assuming arguendo that the Examiner is correct in that an optical pickup does not require an apparatus to generate a seek direction signal, as claimed, the optical pickup of Subspecies B recites the use of a generated seek direction signal.

By way of review and example, claim 8 of Subspecies A recites, among other features, "a light dividing unit to divide a light beam into a main beam and a sub-beam disposed in a line incident on a common track of the optical disk, the sub-beam having an optical aberration that is not disposed in the line to be incident on the common track," "light receiving portions to receive the main beam and sub-beam reflected from the optical disk, and to generate first signals from the reflected main beam and second signals from the reflected sub-beam," and "a signal processing portion to generate the seek direction detecting signal using the first signals and second signals."

By way of review and comparison, claim 19 of Subspecies B recites, among other features, "a light dividing unit to divide the light beam into a main beam and a sub-beam disposed in a line to be incident on a common track of the optical disk, the sub-beam having an optical aberration that is not disposed in the line to be incident on the common track," "light receiving portions to receive the main beam and sub-beam reflected from the optical disk, and to generate first signals from the reflected main beam and second signals from the reflected sub-beam," and "a signal processing portion to generate the seek direction detecting signal using the first signals and the second signals."

As such, while the Examiner may be correct that the optical pickup of claim 19 could be used without a generated seek direction, claim 19 recites the generated seek direction detecting signal such that the invention.

As noted in MPEP 806.05(c), a combination and a subcombination may be different inventions where "it can be shown that a combination *as claimed*: (A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and (B) the subcombination can be shown to have utility either by itself or in other and different relations" (italics added). As such, the focus in determining whether the combination is different from a subcombination is based upon the claimed invention. As claim 19, and claims depending from claim 19, recites the use of the generated seek direction, it is respectfully submitted that the Examiner has not analyzed the invention of Subspecies B to determine if, *as claimed*, the optical pickup of Subspecies B is separately usable from the invention of Subspecies A. Therefore, it is respectfully submitted that the Examiner has not set forth sufficient evidence that the invention as claimed in claims 1-5, 8, 9, 12-14, 16-18, and 37-39 is separately usable from the invention as claimed in claims 19, 20, 23-25, 28, and 30-33 as is required to maintain a prima facie restriction requirement under the two way standard set forth in at least MPEP 806.05(c).

Lastly, while it is noted that the Examiner has identified different sub-subclassifications for the claims, it is believed that classification, and especially at a sub-subclassification level, is not conclusive on the question of restriction. It is believed, moreover, that evaluation of both sets of claims would not provide an undue burden upon the Examiner at this time in comparison with the additional expense and delay to Applicants in having to protect the additional subject matter recited by the Subspecies B claims by filing a divisional application.

MPEP §803 sets forth the criteria for restriction between patentably distinct inventions. (A) indicates that the inventions must be independent (see MPEP §802.01, §806.04, §808.01) or distinct as claimed (see MPEP §806.05-806.05(i)); and (B) indicates that there must be a serious burden on the Examiner if restriction is required (see MPEP §803.02, §806.04(a)- §806.04(i), §808.01(a) and §808.02). As such, beyond showing separate sub-subclassifications in the same subclass of the same class, it is respectfully submitted that the Examiner has not set forth sufficient evidence to show that the Examiner will experience a serious burden in examining the combination and subcombinations, as claimed, without imposing restriction which is out of proportion with the serious burden and inconvenience visited upon the applicant if restriction is required.

III. Conclusion

Upon review of references involved in this field of technology, when considering that the invention recited by the Subspecies A and B claims, and by the elected Subspecies A claims, and when all of the other various facts are taken into consideration, it is believed that upon reconsideration of the Examiner's initial restriction requirement, all of the pending claims should be examined in the subject application.


In view of the foregoing, all claims are deemed to be allowable and this application is believed to be in condition for allowance.

If any further fees are required in connection with the filing of this Response, please charge the same to our deposit account number 19-3935.

Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney.

Respectfully submitted,

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